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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,336	02/13/2006	Mikio Fukuda	SAIT4480	3346

5409 7590 04/29/2008

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EXAMINER	
GUZMAN, APRIL S	

ART UNIT	PAPER NUMBER
2618	

MAIL DATE	DELIVERY MODE
04/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/568,336	FUKUDA, MIKIO	
	Examiner	Art Unit	
	APRIL S. GUZMAN	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 February 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *02/13/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/28/2008 has been entered.

Response to Amendment

The Examiner acknowledges the receipt of the Applicant's amendment filed on 01/15/2008. Claims1-2, & 7 have been amended. **Claims 1-15** are therefore still currently pending in the present application.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4-9, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lee et al. (WO 02/19759 A1)** herein referred to as Lee '759, in view of **Lee et al. (WO 2004/032566 A1)** herein referred to as Lee '566, and further in view of Applicant's admission to prior art.

Consider **claim 1**, Lee '759 teach a portable telephone using a bone conduction device (read as bone-conductor vibrator 50) (page 1 lines 24-30, and page 3 lines 27-31, and page 6 liens 28-30) comprising:

a bone conduction device having an outer surface edge (read as bottom end of circular base plate 52 placed at the bottom end of the bone-conductor vibrator 50) (Figure 3, and page 6 lines 28-32);

a cushioning material (read as cushion member 60a and 60b) disposed on said outer surface edge of said bone conduction device (read as cushion member bonded to the lower surface of the base plate 52) (Figure 3, and page 9 lines 3-13);

a gap formed between said bone conduction device and housing (read as the space between the circular base plate 52 and the housing of the telephone occupied by cushion member 60b) (Figure 4, and page 9 lines 3-13); and

a vibration surface of said bone conduction device (read as cushion member 60a bonded to the upper surface of the diaphragm 56b of the armature 56) positioned to be slightly extended outward from said housing by said cushioning material (read as cushion member 60a bonded to the upper surface of the diaphragm 56b of the armature 56 wherein the cushion member contacts a human body directly and controls the vibrating characteristics of the vibrator 50 wherein the output of the vibrator 50 varies according to the thickness of the cushion members 60a and 60b) (page 9 lines 3-13).

However, Lee '759 fail to teach a housing having a concave portion with a bottom portion and an inner edge surface, which is larger in diameter than said bone conduction device, and wherein said housing forms a main body of the telephone; and the cushioning material disposed on said inner edge surface of said concave portion of said housing.

In the related art, Lee '566 teach a housing having a concave portion (read as the opening of the mobile phone that contains the bone-conductor speaker 80 shown in Figure 4) with a bottom portion and an inner edge surface (read as the surface where the bone-conductor speaker 80 comes in contact with the mobile phone shown in Figure 4), which is larger in diameter than said bone conduction device (read as the opening of the mobile phone that has a diameter that is large enough to contain the bone-conductor speaker 80 which is provided at the inner side of the upper portion of the cover of the mobile phone shown in Figure 4), and wherein said housing forms a main body of the telephone (read as mobile phone has a main body portion 84 and a cover 86) (Figure 4, and page 18 lines 5-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lee '566 into the teachings of Lee '759 for

the purpose of allowing the user of a mobile phone to hear the sound by the vibrational hearing function and the acoustic hearing function simultaneously.

However, Lee'759 as modified by Lee '566 fail to teach the cushion material disposed between said inner edge surface of said concave portion of said housing.

Applicant's admission of prior art teach the cushion material disposed between said inner edge surface of said concave portion of said housing (read as cushioning material 34 is provided in an area extending from such bottom surface to a side surface of the concave portion 33) (page 1 paragraph [0002]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Applicant's admission of prior art into the teachings of Lee' 759 as modified by Lee '566 for the purpose of keeping the bone conduction speaker in effective isolation.

Consider **claim 4, as applied to claim 1**, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art further teach wherein the portable telephone is a foldable type provided with a housing constructed of two housing portions (read as mobile phone has a main body portion 84 and a cover 86) foldable relative to each other (Lee '566 - Figure 4, and page 18 lines 5-18); and

a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 4 and page 18 lines 5-18).

Consider **claim 5, as applied to claim 1**, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art teach wherein the portable telephone is a foldable

type provided with a housing constructed of two housing portions (read as mobile phone has a main body portion 84 and a cover 86) foldable relative to each other (Lee '566 - Figure 4, and page 18 lines 5-18); and a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 4 and page 18 lines 5-18).

However, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art fail to specifically teach wherein the portable telephone is a rotatable type provided with a housing constructed of two housing portions rotatable relative to each other; and a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions when the two housing portions are rotated closed.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone that is a foldable type provided with two housing portion as taught by Lee '759 as modified by Lee '566 and further in view of Applicant's admission of prior art can be substituted with a portable telephone that is a rotatable type with two housing portions, which is well known in the art. It would have been obvious that the substitution of one known type of portable phone, such as a foldable type with two housing portions, for another type of portable phone, such as a rotatable type with two housing portions, would have yielded predictable results to one of ordinary skill in the art at the time of the invention and allowing the user to use a bone conduction device in any alternate type of portable telephone for the purpose of the user's preference.

Consider **claim 6, as applied to claim 1**, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art teach wherein the portable telephone is a foldable

type provided with a housing constructed of two housing portions (read as mobile phone has a main body portion 84 and a cover 86) foldable relative to each other (Lee '566 - Figure 4, and page 18 lines 5-18); and a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 4 and page 18 lines 5-18).

However, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art fail to teach wherein the portable telephone is a slidable type provided with a housing constructed of two housing portions slidable relative to each other when the telephone is in a closed position; and when in the closed position of the telephone, a vibration surface of said bone conduction device abuts an inner surface of one of said housing portions, which is disposed oppositely from said other housing portions, wherein said other housing portions carries said bone conduction device of said housing.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone that is a foldable type provided with two housing portion as taught by Lee '759 as modified by Lee '566 and further in view of Applicant's admission of prior art can be substituted with a portable telephone that is a slidable type with two housing portions, which is well known in the art. It would have been obvious that the substitution of one known type of portable phone, such as a foldable type with two housing portions, for another type of portable phone, such as a slidable type with two housing portions, would have yielded predictable results to one of ordinary skill in the art at the time of the invention and allowing the user to use a bone conduction device in any alternate type of portable telephone for the purpose of the user's preference.

Consider **claim 7**, Lee '759 teach a portable telephone using a bone conduction device (read as bone-conductor vibrator 50) (page 1 lines 24-30, and page 3 lines 27-31, and page 6 liens 28-30) comprising:

a bone conduction device (read as bone-conductor vibrator 50) (page 6 lines 28-30);

a device holder (read as frame 51, the base plate 52 and armature 56) made of a resilient material wherein said device holder is constructed of a container portion (read as frame 51), wherein said container portion carries said bone conduction device therein (page 6 lines 28-32, and page 7 lines 7-12); and

a gap formed between said bone conduction device and housing (read as the space between the circular base plate 52 and the housing of the telephone occupied by cushion member 60b) (Figure 4, and page 9 lines 3-13).

However, Lee '759 teach a housing having a device installation opening; a fixing portion and wherein said fixing portion is fixedly mounted on an inner surface of said device installation opening of said housing of the telephone and said bone conduction device extends from said housing.

In the related art, Lee '566 teach a housing having a device installation opening (read as mobile phone has a main body portion 84 and a cover 86, the bone conduction speaker 80 is provided at the inner side of the upper end portion of the cover 86 of the mobile phone) and said bone conduction device extends from said housing (Figure 4, and page 18 lines 5-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Lee '566 into the teachings of Lee '759 for

the purpose of allowing the user of a mobile phone to hear the sound by the vibrational hearing function and the acoustic hearing function simultaneously.

Lee '759 as modified by Lee '566 fail to teach a fixing portion and wherein said fixing portion is fixed mount on an inner surface of said device installation opening of said housing.

Applicant's admission to prior art shown in Figure 11 shows a fixing portion (read as portion of housing that the screw is fixed to shown in Figure 11) wherein said fixing portion is fixed mounted on an inner surface of said device installation opening of said housing (shown in Figure 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Applicant's admission of prior art into the teachings of Lee' 759 as modified by Lee '566 for the purpose of keeping the bone conduction speaker in effective isolation.

Consider **claim 8, as applied to claim 7**, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art further teach wherein an abutting plate is fixedly mounted on said bone conduction device to cover a front surface side of said container portion (read as cushion member 60a bonded to the upper surface of the diaphragm 56b of the armature 56), wherein said plate is so arranged as to slightly extend outward from said housing (read as the output of the vibrator 50 varies according to the thicknesses of the cushion members 60a and 60b the thickness resulting in the plate extending outward from housing) (Lee '759 - page 9 lines 3-13).

Consider **claim 9, as applied to claim 8**, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art further teach wherein a circular rib for receiving

therein a peripheral edge portion of a rear surface of said abutting plate is provided in a front surface side of said container portion (read as armature 56, including a rim portion 56a and a circular-shaped diaphragm 56b which is integrally formed with the rim portion 56a while being stepped down along the inner periphery of the rim portion 56a, is coupled to the opened top end of the frame 51) (Lee '759 - page 7 lines 17-21).

Consider **claim 10, as applied to claim 1**, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art teach wherein the portable telephone is a foldable type provided with a housing constructed of two housing portions (read as mobile phone has a main body portion 84 and a cover 86) foldable relative to each other (Lee '566 - Figure 4, and page 18 lines 5-18); and a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 4 and page 18 lines 5-18).

However, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art teach fail to teach wherein the portable telephone is a rotatable type provided with a housing constructed of two housing portions rotatable relative to each other in a closed position the telephone said vibration surface of said bone conduction device abuts one of said two housing portions; an inner surface of one of said two housing portions oppositely disposed from the other one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone that is a foldable type provided with two housing portion as taught by Lee '759 as modified by Lee '566 and further in view of Applicant's admission of prior art can be substituted with a portable telephone that is a rotatable type with two housing portions, which is well known in the

art. It would have been obvious that the substitution of one known type of portable phone, such as a foldable type with two housing portions, for another type of portable phone, such as a rotatable type with two housing portions, would have yielded predictable results to one of ordinary skill in the art at the time of the invention and allowing the user to use a bone conduction device in any alternate type of portable telephone for the purpose of the user's preference.

Consider **claim 13, as applied to claim 1**, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art further teach wherein the portable telephone is a foldable type provided with a housing constructed of two housing portions (read as mobile phone has a main body portion 84 and a cover 86) foldable relative to each other (Lee '566 - Figure 4, and page 18 lines 5-18); and a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 4 and page 18 lines 5-18).

However, Lee '759 as modified by Lee'566 and further modified by Applicant's admission of prior art fail to teach wherein the portable telephone is a slidable type provided with a housing constructed of two housing portions slidable relative to each other; and a closed position of the telephone, wherein said vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone that is a foldable type provided with two housing portion as taught by Lee '759 as modified by Lee '566 and further in view of Applicant's admission of prior art can be substituted with a portable telephone that is a slidable type with two housing portions, which is well known in the

art. It would have been obvious that the substitution of one known type of portable phone, such as a foldable type with two housing portions, for another type of portable phone, such as a slidable type with two housing portions, would have yielded predictable results to one of ordinary skill in the art at the time of the invention and allowing the user to use a bone conduction device in any alternate type of portable telephone for the purpose of the user's preference.

Claims 2-3, 11-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lee et al. (WO 02/19759 A1)** herein referred to as Lee '759, in view of **Clark (U.S. Patent #6,134,336)** and further in view of Applicant's admission of prior art.

Consider **claim 2**, Lee '759 teach a portable telephone using a bone conduction device (read as bone-conductor vibrator 50) (page 1 lines 24-30, and page 3 lines 27-31, and page 6 liens 28-30) comprising:

a bone conduction device having an outer surface edge (read as bottom end of circular base plate 52 placed at the bottom end of the bone-conductor vibrator 50) (Figure 3, and page 6 lines 28-32);

a cushioning material (read as cushion member 60a and 60b) disposed on said outer surface edge of said bone conduction device (read as cushion member bonded to the lower surface of the base plate 52) (Figure 3, and page 9 lines 3-13); and

a vibration surface of said bone conduction device (read as cushion member 60a bonded to the upper surface of the diaphragm 56b of the armature 56) extended outward from said housing (read as cushion member 60a bonded to the upper surface of the diaphragm 56b of the

armature 56 wherein the cushion member contacts a human body directly and controls the vibrating characteristics of the vibrator 50 wherein the output of the vibrator 50 varies according to the thickness of the cushion members 60a and 60b) (page 9 lines 3-13).

However, Lee '759 fail to teach a housing having a surface and a through-hole portion, wherein said through-hole portion is configured to be larger than said bone conduction device, wherein said housing forms a main body of the telephone; and the cushioning material is disposed between an inner surface of said through-hole portion.

In the related art, Clark teach a housing having a surface (read as upper housing 102 of radiotelephone 100 is formed at least in part by a housing portion 116 and a housing portion 118 and a front surface 112 of upper housing 102 has an ear placement region 114) (column 4 lines 18-21) and a through-hole portion (read as plurality of openings 120), wherein said through-hole portion is configured to be larger than said bone conduction device (read as plurality of openings 120 is formed on housing portion 116 and positioned within ear placement region 114 generally circularly positioned outside of and around the plurality of openings 124. Integrated speaker assembly 400 of portable radiotelephone includes housing portions 116 and 118) (column 4 liens 31-37, and column 4 lines 56-65), wherein said housing forms a main body of the telephone (read as portable radiotelephone 100 has an upper housing 102 and a lower housing 104 rotatably connected via a hinge 105 forming a handheld housing for a portable radiotelephone 100) (column 4 lines 5-8).

Therefore, it would have been obvious to one of ordinary skill in the art a the time the invention was made to incorporate the teachings of Clark into the teachings of Lee '759 for the

purpose of providing a combination of speaker, enclosure and preconditioning electrical circuitry that provides an acceptable audio quality.

Lee '759 as modified by Clark fail to teach the cushioning material disposed between an inner surface of said through-hole portion.

Applicant's admission of prior art teach cushioning material is provided on an area of the side surface of the housing 32 containing the bone conduction speaker (page 1 paragraph [0002]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Applicant's admission of prior art into the teachings of Lee' 759 as modified by Clark for the purpose of keeping the bone conduction speaker in effective isolation.

Consider **claim 3, as applied to claim 2**, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art further teach wherein an opposite side of said bone conduction device also serves as a vibration surface (read as cushion members 60a and 60b are bonded to the upper surface of the diaphragm 56b of the armature 56 and to the lower surface of the base plate 52, respectively. Cushion members 60a and 60b contact direct a human body, especially the head, and control the vibrating characteristics of the vibrator 50.) (Lee '759 – page 9 lines 3-13).

Consider **claim 11, as applied to claim 2**, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art teach wherein the portable telephone is a foldable type provided with a housing constructed of two housing portions foldable relative to each other (read as portable radiotelephone 100 has an upper housing 102 and a lower housing 104 rotatably

connected via a hinge 105 forming a handheld housing for a portable radiotelephone 100) (column 4 lines 5-8); and a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 1, and column 4 lines 5-8).

However, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art fail to teach wherein the portable telephone is a rotatable type provided with a housing constructed of two housing portions rotatable relative to each other; and a closed position the telephone, wherein said vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone that is a foldable type provided with two housing portion as taught by Lee '759 as modified by Clark and further modified by Applicant's admission of prior art can be substituted with a portable telephone that is a rotatable type with two housing portions, which is well known in the art. It would have been obvious that the substitution of one known type of portable phone, such as a foldable type with two housing portions, for another type of portable phone, such as a rotatable type with two housing portions, would have yielded predictable results to one of ordinary skill in the art at the time of the invention and allowing the user to use a bone conduction device in any alternate type of portable telephone for the purpose of the user's preference.

Consider **claim 12, as applied to claim 3**, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art teach wherein the portable telephone is a foldable type provided with a housing constructed of two housing portions foldable relative to each other

(read as portable radiotelephone 100 has an upper housing 102 and a lower housing 104 rotatably connected via a hinge 105 forming a handheld housing for a portable radiotelephone 100) (column 4 lines 5-8); and a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 1, and column 4 lines 5-8).

However, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art fail to teach wherein the portable telephone is a rotatable type provided with a housing constructed of two housing portions rotatable relative to each other; and a closed position the telephone, wherein said vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone that is a foldable type provided with two housing portion as taught by Lee '759 as modified by Clark and further modified by Applicant's admission of prior art can be substituted with a portable telephone that is a rotatable type with two housing portions, which is well known in the art. It would have been obvious that the substitution of one known type of portable phone, such as a foldable type with two housing portions, for another type of portable phone, such as a rotatable type with two housing portions, would have yielded predictable results to one of ordinary skill in the art at the time of the invention and allowing the user to use a bone conduction device in any alternate type of portable telephone for the purpose of the user's preference.

Consider **claim 14, as applied to claim 2**, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art teach wherein the portable telephone is a foldable

type provided with a housing constructed of two housing portions foldable relative to each other (read as portable radiotelephone 100 has an upper housing 102 and a lower housing 104 rotatably connected via a hinge 105 forming a handheld housing for a portable radiotelephone 100) (column 4 lines 5-8); and a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 1, and column 4 lines 5-8).

However, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art fail to teach wherein the portable telephone is a slidable type provided with a housing constructed of two housing portions slidable relative to each other; and a closed position of the telephone, wherein said vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone that is a foldable type provided with two housing portion as taught by Lee '759 as modified by Clark and further modified by Applicant's admission of prior art can be substituted with a portable telephone that is a slidable type with two housing portions, which is well known in the art. It would have been obvious that the substitution of one known type of portable phone, such as a foldable type with two housing portions, for another type of portable phone, such as a slidable type with two housing portions, would have yielded predictable results to one of ordinary skill in the art at the time of the invention and allowing the user to use a bone conduction device in any alternate type of portable telephone for the purpose of the user's preference.

Consider **claim 15, as applied to claim 3**, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art teach wherein the portable telephone is a foldable type provided with a housing constructed of two housing portions foldable relative to each other (read as portable radiotelephone 100 has an upper housing 102 and a lower housing 104 rotatably connected via a hinge 105 forming a handheld housing for a portable radiotelephone 100) (column 4 lines 5-8); and a folded position of the telephone, wherein a vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions (Figure 1, and column 4 lines 5-8).

However, Lee '759 as modified by Clark and further modified by Applicant's admission of prior art fail to teach wherein the portable telephone is a slidable type provided with a housing constructed of two housing portions slidable relative to each other; and a closed position of the telephone, wherein said vibration surface of said bone conduction device abuts an inner surface of one of said two housing portions.

Nonetheless, the Examiner takes Official Notice of the fact that the portable telephone that is a foldable type provided with two housing portion as taught by Lee '759 as modified by Clark and further modified by Applicant's admission of prior art can be substituted with a portable telephone that is a slidable type with two housing portions, which is well known in the art. It would have been obvious that the substitution of one known type of portable phone, such as a foldable type with two housing portions, for another type of portable phone, such as a slidable type with two housing portions, would have yielded predictable results to one of ordinary skill in the art at the time of the invention and allowing the user to use a bone

conduction device in any alternate type of portable telephone for the purpose of the user's preference.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see PTO-892 Notice of References Cited.

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April S. Guzman whose telephone number is 571-270-1101. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Anderson can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April S. Guzman
A.S.G/asg

/April S. Guzman/
Examiner, Art Unit 2618

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